

REMARKS

Claims 1-18 remain pending in the above-identified application. Applicant has amended Claims 1, 2, 10 and 11, and this amendment is not intended to overcome any application of prior art and nor is it intended to limit the scope of the claims in any manner. Support for the amendment to Claims 1-18 can be found within the specification, such as, on page 6, lines 1-8 or paragraph 20, and therefore, no new search would be required. Furthermore, this amendment to Claims 1-18 does not introduce new matter. In view of the above amendment and the following remarks, it is respectfully submitted that all pending claims are allowable.

The Rejection of Claims 1-6, 8 and 9 under 35 U.S.C. §102(b) should be withdrawn

Claims 1-6, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jones, Jr., (U.S. Patent No. 5,402,396) (hereinafter Jones). Applicant respectfully submits that Claims 1-6, 8 and 9 are not anticipated by Jones for at least the following reasons.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added). Jones does not disclose each and every element of the claimed invention.

The Applicant has amended Claims 1-6, 8 and 9 and therefore the rejection of these claims under Jones is now moot.

The Examiner had objected to the previous amendment to Claims 1-6, 8 and 9, stating that "the limitation "to provide a visual reminder that the alarm has been set"" is a "functional language" and that "Whether the user is visually reminded that an alarm is set is immaterial to the structure and operation of the alarm clock apparatus." Due to the objection of the Examiner to the claim language, the Applicant has amended Claims 1-6, 8 and 9 to provide "structure and operation" to the "functional language" in order to overcome the Examiner's objection to the language. As a result of this amendment to Claims 1-6, 8 and 9, no new search would be required and nor does it add any new matter.

Applicant has discussed Jones in paragraph 4, of the instant patent application and that discussion is incorporated herein by reference. The Applicant would also like to state that there is no teaching in Jones that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set." as

disclosed and claimed by the Applicant in Claims 1-6, 8 and 9.

In fact, Jones teaches away from Applicant's invention when he provides a separate "alarm ON/OFF button 24" (column 2, line 22) and a separate "night light 28" which "is disposed between the alarm ON/OFF button 24 and the sleep button 26." (Column 2, lines 27-29). Whereas, the Applicant teaches that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set," as disclosed and claimed by the Applicant in Claims 1-6, 8 and 9.

Additionally, Jones teaches away from Applicant's invention when he provides a "switch 30 which ... allows the night-light to be switched off." (Column 2, lines 35-38.) Whereas, the Applicant teaches that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set," as disclosed and claimed by the Applicant in Claims 1-6, 8 and 9.

Furthermore, Jones teaches away from Applicant's invention when he teaches "that the translucent cover" be "adapted to permit light to be more readily transmitted through the side edges" so that "the ON/OFF" button 24 "can be specifically illuminated." (Column 2, lines 41-45.) Whereas, the Applicant teaches that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set," as disclosed and claimed by the Applicant in Claims 1-6, 8 and 9.

In light of these facts Applicant respectfully submits that Jones does not anticipate the invention of independent Claim 1.

Claims 2-6, 8 and 9 depend from, and include all the limitations of Claim 1, and therefore these claims are not anticipated by Jones.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102 (b) with respect to Claims 1-6, 8 and 9 is hereby respectfully requested.

The Rejection of Claim 7 under 35 U.S.C. § 103(a) should be withdrawn

Claim 7 stands rejected under 35 U.S.C. § 103(a). The Patent Office has contended that this claim is unpatentable over Jones, Jr., (U.S. Patent No. 5,402,396) (hereinafter Jones).

Applicant respectfully submits that Claim 7 is not unpatentable over Jones for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied 111 S.Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. § 2143. Applicant respectfully submits that neither of these criteria for obviousness are met here.

Applicant has amended Claim 7 and therefore the rejection of this claim under Jones is now moot.

The Examiner had objected to the previous amendment to Claim 7, stating that "the limitation "to provide a visual reminder that the alarm has been set"" is a "functional language" and that "Whether the user is visually reminded that an alarm is set is immaterial to the structure and operation of the alarm clock apparatus." Due to the objection of the Examiner to the claim language, the Applicant has amended Claim 7 to provide "structure and operation" to the "functional language" in order to overcome the Examiner's objection to the language. As a result of this amendment to Claim 7, no new search would be required and nor does it add any new matter.

The earlier discussion with reference to Jones is incorporated herein by reference. Additionally, there is no teaching in Jones that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set," and where the "alarm-clock is powered by a power source selected from a group consisting of an alternating current source between about 120 volts and about 240 volts, and a direct current source between about 1 volt and about 24 volts" as disclosed and claimed by the Applicant in Claim 7.

In light of these facts Applicant respectfully submits that Jones does not make unpatentable the invention of Claim 7.

Additionally, Claim 7 depends from, and includes all the limitations of Claim 1, and therefore is not unpatentable over Jones.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claim 7 is hereby respectfully requested.

The Rejection of Claims 10-18 under 35 U.S.C. § 103(a) should be withdrawn

Claims 10-18 stand rejected under 35 U.S.C. § 103(a). The Patent Office has contended that these claims are unpatentable over Jones, Jr., (U.S. Patent No. 5,402,396) (hereinafter Jones) in view of Parissi (U.S. Patent No. 2,444,748) (hereinafter Parissi).

Applicant respectfully submits that Claims 10-18 are not unpatentable over Jones in view of Parissi for at least the following reasons.

Applicant has amended Claims 10-18 and therefor the rejection of these claims under Jones in view of Parissi is now moot.

The Examiner had objected to the previous amendment to Claims 10-18, stating that "the limitation "to provide a visual reminder that the alarm has been set"" is a "functional language" and that "Whether the user is visually reminded that an alarm is set is immaterial to the structure and operation of the alarm clock apparatus." Due to the objection of the Examiner to the claim language, the Applicant has amended Claims 10-18 to provide "structure and operation" to the "functional language" in order to overcome the Examiner's objection to the language. As a result of this amendment to Claims 10-18, no new search would be required and nor does it add any new matter.

The earlier discussion with reference to Jones and the criteria to apply in obviousness ruling are incorporated herein by reference. Parissi discloses a clock with visible and audible alarm means. The Applicant would like to respectfully state that Jones in view of Parissi does not overcome the deficiencies of the prior art, for example Jones in view of Parissi does not teach that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set," as disclosed and claimed by the Applicant in Claims 10-18.

In fact, Parissi teaches away from Applicant's invention when he teaches that the "principal object of my invention is to provide an alarm clock which ... will give a visible signal ... [to] awaken a normal sleeper." (Column 1, lines 15-20.) Whereas, Applicant in Claims 10-18 teaches that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set."

Furthermore, Parissi teaches away from Applicant's invention when he teaches that

"In fact, if the lamp is to be used solely as a signal or alarm, the switch 12 [light on or off switch] may be omitted" (column 2, lines 21-22) and thus the lamp 10 would remain in an off position and would not be lit after the alarm has been set and would only give a visible signal when the alarm goes off. Whereas, Applicant in Claims 10-18 teaches that "when the alarm is set the alarm button activates at least one luminescent device, and upon setting of the alarm the luminescent device radiates light through the alarm button to provide a visual reminder that the alarm has been set."

In light of these facts Applicant respectfully submits that Jones in view of Parissi does not make unpatentable the invention of independent Claim 10.

Claims 11-18 depend from, and include all the limitations of Claim 10, and therefore these claims are not unpatentable over Jones in view of Parissi.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claims 10-18 is hereby respectfully requested.


CONCLUSION:

It is therefore respectfully submitted that Claims 1-18 are now all allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Applicant respectfully requests that this Amendment After Final be entered so as to put the instant Patent Application in either a condition for Allowance or in a condition for Appeal.

The Examiner is also invited to contact the undersigned attorney if any communication is believed to be helpful in advancing the examination of the present application.

Respectfully submitted,

By: 

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